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OFFICE OF PETITIONS

In re Application of
Dane K. Fisher et al.
Application No. 09/394,745
Filed: September 15, 1999
For: Nucleic Acid Molecules and Other Molecules Associated with Plants

: DECISION ON PETITION
: UNDER 37 CFR 1.181(a)(3)

This is a decision on the petition filed on July 9, 2003, which is being treated as a petition under 37 CFR 1.181(a)(3) to invoke the supervisory authority of the Director of the United States Patent and Trademark Office (Director) to review the May 12, 2003 decision of the Director of Technology Center 1600 (Technology Center Director). The Technology Center Director's decision of May 12, 2003 denied the petition under 37 CFR 1.144 of April 14, 2003, which petition requested withdrawal of the restriction requirement set forth by the examiner in the above-identified application.

The petition to invoke the supervisory authority of the Director to review the May 12, 2003 decision of the Technology Center Director is **dismissed** as premature.

A review of the above-identified application reveals that: (1) claims 8 through 11 are the only claims pending in the above-identified application; (2) the final Office action of November 11, 2002 includes a rejection of claims 8 through 10 under 35 U.S.C. § 112, ¶ 2, a rejection of claims 8 through 11 under 35 U.S.C. § 101, and a rejection of claims 8 through 11 under 35 U.S.C. § 112, ¶ 1; (3) the rejections of claims 8 through 11 are the subject of an appeal to the Board of Patent Appeals and Interferences; and (4) no claim has been withdrawn from consideration as a result of the restriction requirement at issue in the above-identified application.

Since no claim has been withdrawn from consideration in the above-identified application as a result of the restriction requirement that is the subject of the instant petition, the examiner is not refusing to examine any claim in the above-identified application as a result of the restriction requirement and petitioner's complaints concerning this restriction requirement are premature.

While Office personnel are to state all non-cumulative reasons and bases for rejecting claims in the first Office action under the Office's "compact prosecution" policy, this policy is a matter of internal Office management and does not vest applicants with the right to have their applications examined in any particular manner. The Office's reviewing court has indicated that it is permissible and even appropriate to defer imposition of any applicable prior art based rejection until the non-prior art based rejections have been resolved. See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962). In the above-identified application, an affirmance of the rejection of claims 8 through 11 under 35 U.S.C. § 101 or under 35 U.S.C. § 112, ¶ 1, would moot any complaint concerning how these claims have been treated relative to the prior art. In any event, the Office's reviewing court has also indicated that a patent applicant is not "adversely affected or aggrieved by agency action" by the Office's failure to enter a prior art rejection. See Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1988) (patent applicants are not "adversely affected" by an examiner's failure to enter a rejection).

Therefore, the petition to request further review of the restriction requirement at issue is premature unless and until at least one claim is withdrawn from consideration as a result of the restriction requirement.

Telephone inquires regarding this decision may be directed to Petitions Examiner Brian Hearn at (703) 305-1820.

Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy

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